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MORRISON & FOERSTER, LLP 555 WEST FIFTH STREET SUITE 3500 LOS ANGELES, CA 90013-1024			EXAMINER LEROUX, ETIENNE PIERRE	
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			2161	

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/823,704	Applicant(s) ITO ET AL.	
	Examiner Etienne P LeRoux	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 6, 9, 12, 22, 24, 34, 40-47 and 50-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 6, 9, 12, 22, 24, 34, 40-47 and 50-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                            | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3/2006</u> | 6) <input type="checkbox"/> Other:  |

*Claims Status*

Claims 1, 4, 6, 9, 12, 22, 24, 34, 40-47 and 50-53 are pending. Claims 2, 3, 5, 7, 8, 10, 11, 13-21, 23-33, 35-39, 48, 49, 54 and 55 are canceled. Claims 1, 4, 6, 9, 12, 22, 34, 40-47 and 50-53 are rejected as detailed below.

*Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4, 6, 9 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites “one or more items of first display information each for displaying an emulation screen emulating a screen of an online product selling site that is accessible via the network.” The metes and bounds of the present invention cannot be determined because it is unclear what comprises a screen of an online selling site and what comprises a screen that emulates a screen of an online selling site. The specification does not particularly point out what comprises an emulating screen. In fact not a single citation of an emulation screen is included in the specification. For purposes of this examination on the merits, it will be assumed that a simulation screen is a screen that displays one or more products which are similar to the products displayed on the website.

Claims 4, 6, 9 and 22 are rejected for including language similar to claim 1.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 1, 4, 6, 9, 12, 22, 34, 42, 43, 45, 52 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 6,535,889 issued to Headrick et al (hereafter Headrick) in view of US Pat No 6,156,964 issued to Sahai et al (hereafter Sahai).

Claims 1, 4, 6, 9, 12, 22, 24, 34, 42, 43, 45, 52 and 53:

Headrick discloses an apparatus for retrieving information from a site on a network, said apparatus comprising:

a display device [Fig 1, 126], an operator unit [Fig 1, 126], a processor device [ Fig 1, 100] coupled with a storage medium [Fig 1, 122], said display device and said operator unit, said storage medium having prestored therein:

one or more items of first display information each for displaying an emulation screen [Fig 2, static media object, Fig 3c, ] emulating a screen of an online product selling site [Figs 3a, 3d] that is accessible via the network, said first display information including product display information [Fig 3c, hat 706, shirt 708] for displaying on the emulation screen information describing one or more of a plurality of products [Fig 3c, hat 706, shirt 708] said plurality of products correspond to products displayed on said online selling site and network address [identification tag 204A associated with a WWW address, col 9, line 32] information assigned to the selling site for calling up the selling site [Fig 3d]

said processor device being adapted to:

present to a user a list screen listing a plurality of products

receive from the user via the list screen a selection of a particular product

read out [Fig 5, par 47] a particular one of the items of the first display information stored in said external storage medium corresponding to the emulation screen of the product selected by the user;

cause the emulation screen described by the read-out first display information, to be displayed on said display device; wherein said emulation screen displays a listing of data contained in the selling site imitated by the emulation screen, and wherein the emulation screen and the screen of the selling site imitated by the emulating screen are substantially similar in layout and function [Figs 3a-3e];

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manipulate via said operator unit, an access button [Fig 3e, 900] on the emulation screen displayed on said display device, to thereby read out the network address information of a particular selling site corresponding to said emulation screen and transmit the read-out network address information to the network,

receive from said site via the internet, second display information for displaying a screen of the site; said screen of the particular selling site corresponding to the product selected by the user

and displaying the screen of the selling site on the display device on the basis of the received second display information [Figs 3a-3e], said screen of the particular selling site corresponding to the product selected by the user

Headrick discloses the essential elements of the claimed invention as noted above but does not disclose an electronic musical product. Sahai discloses an electronic musical product [Fig 1]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Headrick to include an electronic musical product as taught by Sahai for the purpose of allowing a musician to download a piece of music which he/she wishes to play

Claims 41 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Headrick and Sahai as applied to claims 1, 4, 6, 9, 12, 22, 24, 34-39, 42, 43, 45 and 52-55 and further in view of US Pat No 6,735,430 issued to Farley et al (hereafter Farley).

Claim 41:

Headrick discloses the elements of claim 40 as noted above but does not disclose wherein the display information to be transmitted to said client terminal is information for displaying the desired music piece as a musical score. Farley discloses wherein the display information to be

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transmitted to said client terminal is information for displaying the desired music piece as a musical score [col 4, lines 14-25]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Headrick to include wherein the display information to be transmitted to said client terminal is information for displaying the desired music piece as a musical score as taught by Farley for the purpose of providing a means for a person to play an instrument [col 4, lines 14-25]. The skilled artisan would have been motivated to modify Headrick per the above such that a user can obtain a musical score related to an audio clip such that the user can also play the music which he/she heard on the website.

Claim 46:

Headrick discloses the elements of claim 45 as noted above but does not disclose wherein the display information to be transmitted to said client terminal is information for displaying the desired music piece as a musical score. Farley discloses wherein the display information to be transmitted to said client terminal is information for displaying the desired music piece as a musical score [col 4, lines 14-25]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Headrick to include wherein the display information to be transmitted to said client terminal is information for displaying the desired music piece as a musical score as taught by Farley for the purpose of providing a means for a person to play an instrument [col 4, lines 14-25]. The skilled artisan would have been motivated to modify Headrick per the above such that a user can obtain a musical score related to an audio clip such that the user can also play the music which he/she heard on the website.

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Claims 40, 44, 47, 50 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Headrick and Sahai as applied to claims 1, 4, 6, 9, 12, 22, 24, 34-39, 42, 43, 45, 52 and 53 and further in view of Pub No US 2002/0062357 issued to Srinivasan.

Claims 40, 44, 50 and 51:

Headrick discloses:

receiving from said client terminal, first request information designating a desired music piece

on the basis of said first request information received from said client terminal, transmitting to said client terminal, display information for displaying the desired music piece in its entirety so that the entire desired music piece can be displayed on said client terminal on the basis of the display information:

receiving from said client terminal, second request information designating at least a desired portion of the displayed music piece, said desired portion being selected by a user of said client terminal from a single piece corresponding to the displayed music piece

on the basis of said second request information received from said client terminal, creating partial music piece data that represent the desired music piece and correspond to the portion designated by said second request information [Figs 1, 3 and 5]

Headrick discloses the essential elements of the claimed invention as noted above but does not disclose determining a selling price of the created partial music piece data. Srinivasan discloses determining a selling price of the created partial music piece data [paragraph 22]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Headrick to include determining a selling price of the created partial music piece data as



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taught by Srinivasan for the purpose of enabling a customer to record something for a fee [paragraph 22]. The skilled artisan would have been motivated to modify Headrick per the above such that the owner of a website can conduct ebusiness.

Claim 47:

Headrick discloses the elements of claim 44 as noted above but does not disclose wherein the predetermined billing-related information is at least a credit-card number. Srinivasan the predetermined billing-related information is at least a credit-card number [paragraph 22]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Headrick to include the predetermined billing-related information is at least a credit-card number as taught by Srinivasan for the purpose of enabling a customer to record something for a fee [paragraph 22]. The skilled artisan would have been motivated to modify Headrick per the above such that the owner of a website can conduct ebusiness.

***Response to Arguments***

Applicant's arguments submitted 3/2/2006 have been carefully considered but are not persuasive for the reasons given below.

**Applicant Argues:**

Applicant states in the second paragraph of page 23:

As discussed with the examiner during the telephonic interview, Applicants respectfully submit that, with respect to amended claims 1, 4, 6, 9 and 22, neither Headrick nor Sahai contain any disclosure or suggestion of reading display information, from a storage medium, to generate an

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emulation screen that emulates an actual website, where the emulation screen and the emulated screen of the website are substantially similar in design and layout.”

**Examiner Responds:**

Examiner is not persuaded. Examiner responds as below by considering the actual claim limitation(s) as recited in claim 1:

one or more items of first display information each for displaying an emulation screen [Fig 2, static media object, Fig 3c, ] emulating a screen of an online product selling site [Figs 3a, 3d] that is accessible via the network, said first display information including product display information [Fig 3c, hat 706, shirt 708] for displaying on the emulation screen information describing one or more of a plurality of products [Fig 3c, hat 706, shirt 708] said plurality of products correspond to products displayed on said online selling site and network address [identification tag 204A associated with a WWW address, col 9, line 32] information assigned to the selling site for calling up the selling site [Fig 3d]

**Applicant Argues:**

Applicant states in the first paragraph of page 24:

Applicants respectfully submit that the cited reference do[es] not contain any disclosure or suggestion of displaying related display objects of music piece data, where the display objects are displayed in one of two display modes, and where one of the display mode[s] is linked with an address of a server for downloading music piece data specified.

**Examiner Responds:**

Examiner is not persuaded. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the

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rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Sahai in Figure 2 discloses a musical score. Regarding displaying the claimed first and second display modes, applicant is referred to following response by examiner.

Examiner, as best as is possible will respond to above comment by addressing the following claim 34 limitation:

wherein each of the items of specifying information allocated to the related display object having said first display mode specifies a music piece data set capable of being ordered by accessing said server, and a visual presentation of the related display object having said first display mode is linked with an address of the server for downloading the music piece data specified by the item of specifying information corresponding to the related display object.

Headrick discloses column 9, lines 10-40 the following:

Left page 202a comprises a plurality of objects, such a graphic object 206a and text object 208a. Likewise, right page 202b comprises a plurality of objects, including graphic object 206b and text object 208b. Left page 202a has also been imprinted with an associated unique identification tag 204a. Similarly, right page 202b has been imprinted with an associated unique identification tag 204b. As will be described in more detail below, unique identification tags 204a and 204b are utilized to create an association between the static media object, such as left page 202a, and a related interactive electronic representation of the static media object.

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In the illustrative embodiment, unique identification tags 204a and 204b have been shown as a sequence of unique numbers and letters. Unique identification tags 204a and 204b may also comprises information that conveys the specific publication, region, issue, date, or page number of the associated static media object. Unique identification tags 204a and 204b may also comprise information indicating that objects shown within the static media object are eligible for special promotions or discounts. Moreover, unique identification tags 204a and 204b may be shown adjacent to a well-known logo or symbol that a reader may associate with a WWW address. Alternatively, the WWW address may be shown adjacent to the unique identification tag. As will be described in more detail below, the WWW address may be used by the reader to access the interactive electronic representation corresponding to the static media object.

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Referring now to FIG. 3a, additional aspects of the present invention will be described. FIG. 3a is a display screen of a standard WWW browser application program being used to access a web site for displaying an interactive electronic representation of a corresponding traditional static media object that embodies aspects

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of the present invention. WWW browser 112 is a standard WWW browser, such as Microsoft Corporation's Internet Explorer or Netscape Corporation's Netscape Navigator. WWW browser 112 provides functionality for receiving and displaying HTML documents, including active server pages, executing Javascript scripts and Java applications. WWW browser 112 also provides user interface features for navigating to and between WWW sites, such as the RETAILSTREET.COM WWW site 302. The functionality and operation of WWW browser 112 is well known to those skilled in the art.

The above disclosure by Headrick shows Figure 2, left page 202a and right page 202b corresponds to the claimed first mode of display and the interactive electronic representation which has a WWW address corresponds to the second mode of display and the disclosure of an unique identifier tag by Headrick corresponds to the claimed server address.

### *Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

*Contact Information*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached Monday through Friday between 8:00 am and 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Etienne LeRoux

3/21/2006

